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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,512	04/26/2001	Neil D. Nicastro	47089-00051	7331

30223 7590 10/23/2003

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CHICAGO, IL 60606

EXAMINER
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ENATSKY, AARON L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 10/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/842,512

Applicant(s)

NICASTRO ET AL.

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 39-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 39-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges receipt of amendment on 7/31/03. The arguments set forth in the response are addressed herein below. Claims 1-8 and 39-60 are pending and claims 9-38 are cancelled.

### ***Claim Objections***

Claims 1-8 and 39-60 are objected to because of the following informalities: Applicant referencing claim requirements with the phrase "specified game time". The phrase in question does not denote amount of game time provided to players as disclosed in the specification. The current claim language is akin to a point in time versus a period of time, as described in the specification. Applicant needs to revise claim language to properly set forth that game time is referencing a period or amount of time. However, if Applicant's intention was to require a specific point in time, then claims will become subject to rejection under USC § 112 for new matter situations. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 39-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,050,895 to Luciano, Jr. et al. ("Luciano"). Luciano teaches an amusement game

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having both a skill-based and chanced-based game, where the skill-based game is the first game and the chance-based game is a secondary game (Abstract). The chanced-based game can be a slot game, blackjack, keno, poker, and other known chance-based games (6:51-54). The skill-based game can be fighting or racing games (5:12-20). Luciano also teaches the chanced-based game occurs regardless of the skill-based game outcome (7:54-56), a cash prize can be awarded based on the outcome of one or both games (5:50-62), the game machine has a recording medium for later information retrieval (11:34-37), the game machine is able to read player information off of cards (3:20-22), and a user may place a wager on games (8:48-51).

Furthermore, Luciano also teaches a player reward system that can supply points or credits for a skill and chanced based game (5:42-56) and that chance-based outcomes can be used to add to the total collection of points/credits earned in both games (6:51-64). The rewards provided to players are also taught as applicable for use to continue game play (8:48-65). Although Luciano does not disclose specific reference to rewards in terms of amount of game time, the amount of usable game time is art accepted as a function of monetary input, thus equivalent in terms of usage and payback to a user. In the Luciano reference, it is shown that players can be rewarded from both game types using a system that allows continued game play, thus amount rewarded or lost by a player can be the amount of time available to a player. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a functional equivalent of a credit or point reward system and substitute a player reward as amount of additional or decreased game play time available to a player.

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***Response to Arguments***

Applicant's arguments filed 7/31/03 have been fully considered but they are not persuasive. Examiner's response to Applicant's amendments and arguments is detailed in the new rejection found above.

***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,471,584 to Wada et al. Teaches monetary input has a direct and equivalent relationship to available game time.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky  
October 17, 2003

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700